

**Comparison of CPA practice, URAA transitional practice under 37 CFR 1.129(a),  
and new request for continued examination (RCE) practice<sup>1</sup>**

	<b>Continued prosecution application (CPA) under 37 CFR 1.53(d)</b>	<b>URAA transitional practice under 37 CFR 1.129(a)</b>	<b>Request for continued examination (RCE) under proposed 37 CFR 1.112(b)</b>
1	CPA practice is not applicable to provisional applications or during reexamination  Note: CPA practice will be made inapplicable to any utility or original plant applications filed on or after May 29, 2000 (including reissue)	37 CFR 1.129(a) practice is applicable only to original utility or original plant application filed before or on June 8, 1995, and which have been pending for at least two years as of June 8, 1995 (date-wise virtual mutual exclusivity with RCE practice)	RCE practice is not applicable to provisional applications, design applications, applications filed before June 8, 1995, or during reexamination
2	Statutory authority: 35 U.S.C. §§ 111(a), 120, and 121	Statutory authority: Section 532(a)(2)(A) of Pub. L. 103-465 (uncodified)	Statutory authority: 35 U.S.C. § 132(b)
3	The PTO treats a CPA as continued examination of the same application, but it is technically/legally a new application	Further examination under 37 CFR 1.129(a) is in fact continued examination of the same application	A RCE is in fact continued examination of the same application
4	The applicant may defer paying the filing fee for a CPA under 37 CFR 1.53(g)	The applicant may not defer paying the fee for a submission under 37 CFR 1.129(a)	The applicant may not defer paying the fee for a RCE
5	The fee for CPA must be the filing fee: basic filing fee plus any applicable claims fees	PTO sets the fee (need not charge for additional claims)	PTO sets the fee (need not charge for additional claims)

<sup>1</sup> These comparisons assume that the PTO will promulgate regulations providing that: (1) applicants cannot as a matter of right switch inventions during continued examination under 35 U.S.C. § 132(b); (2) CPA practice will be made inapplicable to any utility or plant applications filed on or after May 29, 2000) (which applications are entitled to continued examination under 35 U.S.C. § 132(b)).

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6	<p>A patent issuing on a CPA filed on or after May 29, 2000 is entitled to the patent term adjustment provisions of Public Law 106-113, regardless of the filing date of any prior application of the CPA</p> <p>A patent issuing on a CPA is <b>not</b> entitled to any patent term adjustment accumulated during prosecution of any prior application of the CPA</p>	An application that is eligible for the transitional practice of 37 CFR 1.129(a) is <b>not</b> entitled to the patent term adjustment provisions of Public Law 106-113	<p>Filing an RCE on or after May 29, 2000 will <b>not</b> cause an application to be entitled to the patent term adjustment provisions of Public Law 106-113</p> <p>If an application is entitled to the patent term adjustment provisions of Public Law 106-113 (<i>i.e.</i>, was itself filed on or after May 29, 2000), filing an RCE cuts-off the applicant's ability to accumulate any additional patent term adjustment against the 3-year pendency provision, but does not otherwise affect patent term adjustment</p>
7	No limit on the number of times an applicant may file a CPA to obtain continued examination	An applicant may have only two (2) submissions entered as a matter of right under 37 CFR 1.129(a)	No limit on the number of times an applicant may file a RCE to obtain continued examination
8	A CPA is not entitled to the benefit of a COM under 37 CFR 1.8	A submission under 37 CFR 1.129(a) is entitled to the benefit of a COM under 37 CFR 1.8	A RCE is entitled to the benefit of a COM under 37 CFR 1.8

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9	Applicants may file a continuation or divisional CPA, but not a CIP CPA	Applicants may not switch inventions (divisional equivalent) as a matter of right or add new matter (CIP equivalent)	Applicants may not switch inventions (divisional equivalent) as a matter of right or add new matter (CIP equivalent)
10	A CPA abandons the (previously) pending application: appeals to the BPAI or courts in the prior application become moot automatically	A submission under 37 CFR 1.129(a) does not abandon the (previously and currently) pending application: no appeal issues because PTO requires such submission to be filed before an appeal (to BPAI) brief is filed	A RCE does not abandon the (previously and currently) pending application: to permit RCE after an appeal brief is filed, appeals to the BPAI must be dismissed by operation of PTO rules and applicant must be required to obtain dismissal of any pending court action to restore jurisdiction over the application to the PTO
11	Inventorship carries over unless the applicant provides a statement deleting inventors	Inventorship carries/continues: any change must be via 37 CFR 1.48	Inventorship carries/continues: any change must be via 37 CFR 1.48
12	Small entity status does not carry (but can be claimed by reference to status in prior application or payment of small entity filing fee)	Small entity status carries/continues	Small entity status carries/continues
13	A CPA accompanied by an amendment (preliminary) cancelling all claims makes the CPA improper (not entitled to a filing date)	Submission under 37 CFR 1.129(a) accompanied by an amendment cancelling all claims is simply a non-responsive amendment	RCE accompanied by an amendment cancelling all claims is simply a non-responsive amendment

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